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By: Maisie C. Livengood
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

William J. Dower, et al.

Application No.: 09/661,927

Filed: September 14, 2000

For: SUBSTRATES AND
SCREENING METHODS FOR
TRANSPORT PROTEINS

Examiner: Epperson Jon D.

Art Unit: 1627

RESPONSE TO RESTRICTION
REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is filed in response to the new Restriction Requirement mailed August 16, 2002, which set a one month period for response. Accordingly, this response is timely filed.

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement, Applicants elect, with traverse, to prosecute the claims in Group II (Claim 1, in part, and claims 2-68).

The election is made with traverse for several reasons. First, the Office is restricting a single claim (namely, claim 1) into multiple inventions which is directly contrary to controlling law. As the C.C.P.A. has stated:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of

applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

See, In Re Weber, Soder and Boksay 198 USPQ 328, 331 (C.C.P.A. 1978) (emphasis added).

See also, In Re Haas 179 USPQ 623, 624, 625 (*In Re Haas I*) (C.C.P.A. 1973) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*) (C.C.P.A. 1978).

The Office nonetheless takes the position that restriction of a single claim is warranted because it includes distinct inventions. However, the courts have been clear that the Office cannot restrict a single claim on this basis. Specifically, the courts have ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See, In Re Weber, Soder and Boksay, In Re Haas I* and *In Re Haas II, supra*. As noted in *In Re Weber, Soder and Boksay*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- no matter how broad, which means no matter how many independently patentable inventions may fall within it.

See, In Re Weber, Soder and Boksay at 334.

Instead of imposing a restriction requirement on a single claim, the Office may limit initial examination to a reasonable number of species encompassed by the claim. *See*, 37 C.F.R. § 1.146. This practice strikes an appropriate balance between the concerns of the Office regarding administrative concerns and unduly burdensome examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated,

provided the dictates of 35 U.S.C. § 112 are complied with. *See*, the MPEP at 803.02. *See also*, *In Re Wolfrum* 179 USPQ 620 (C.C.P.A. 1973) and *In re Kuehl* 177 U.S.P.Q. 250 (C.C.P.A. 1973). Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to file multiple divisional applications which are incapable of capturing the intended scope of the application.

Thus, to be consistent with the foregoing case law and rules, if any type of election is to be imposed in this application, Applicants submit that it properly should be a species election requirement rather than a restriction requirement. If the Office is inclined to maintain the restriction requirement with respect to claim 1, Applicants request that the Office clearly specify why it deems the foregoing case law not to be controlling with respect to this application.

Applicants also respectfully submit that the restriction requirement should be withdrawn for a completely separate reason, namely that a search of Groups I-III will not constitute an undue burden on the Office. The Restriction Requirement contends that restriction is proper because the inventions have been classified to different classifications (paragraph 10). It is noted, however, that each group has been classified not only to the same class but also the same subclass. This demonstrates the similarity in subject matter within the three groups and indicates that a search could be conducted without undue burden. The Restriction Requirement also contends that the different methods would “require completely different searches” (paragraph 10). Because the Office is restricting a single claim, the methods in the different groups will necessarily largely overlap in scope, thus making a search of each group largely coextensive. Hence, for this reason as well, Applicants respectfully submit that it would not constitute an undue burden on the Office to examine all three groups together.

For all of the foregoing reasons, and for each reason alone, Applicants submit that the restriction requirement imposed in this application should be withdrawn. As noted *supra*, if any type of election is to be required, it properly should be a species election.

RESPONSE TO SPECIES ELECTION REQUIREMENT

If Group II is elected, as here, the Office further requires Applicants to make several species elections (paragraph 13). In response, Applicants elect the following:

Species of ligand: Small molecules (see definition on page 11, lines 1-3). Claims 1-68 read on this species.

Species of complex: The Office states that a specific “compound,” “reporter,” and “linker (if any)” be disclosed. Applicants elect as follows

compound: small molecules. Claims 1-68 read on this species.

reporter: a dye that can interact with an intracellular agent. Claims 1-3, 12-13, 25-38, 40-68 read on this species.

linker: a cleavable linker; if more specificity is required, then a photocleavable linker is elected. Claims 1-54, 56-57, and 59-68 read on this species.

Thus, the elected complex that includes each of the foregoing three elements reads on claims 1-3, 12-13, 25-38, 40-54, 56-57 and 59-68.

Species of cell: CHO cell. Claims 1-24, 35-39 and 41-68 read on this species. Please note, however, that a species cannot be chosen for claims 25-34 and claim 40 as these claims require different cells.

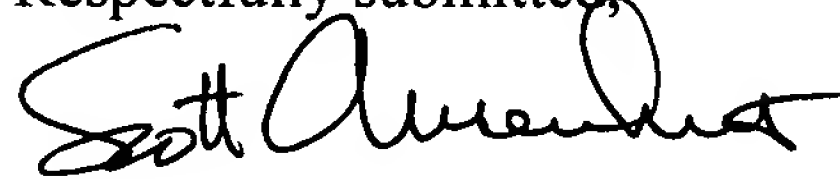
Species of detecting a signal: The elected method for detecting a signal is the one described in claim 12 in which the reporter comprises a detection moiety disposed to interact with an intracellular agent. If the compound complexed with the reporter is a substrate for a carrier-type protein expressed by the cell being tested, the complex containing the reporter and compound are transported into a cell having the intracellular agent, whereby the detection moiety interacts with the intracellular agent to generate a detectable signal, with detection involving detection of the detectable signal. Since the reporter species elected above is a dye, the dye is

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one that can interact with an intracellular species. Claims 1-3, 12-13, 25-38, 40-68 read on this species.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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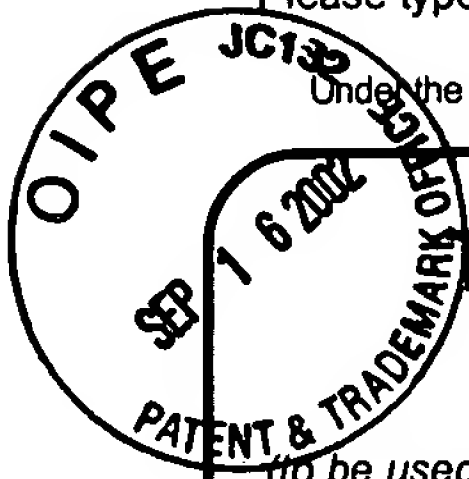
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/661,927	
	Filing Date	September 14, 2000	
	First Named Inventor	Barrett, Ronald W.	
	Group Art Unit	1627	
	Examiner Name	Epperson, Jon D.	
Total Number of Pages in This Submission	1	Attorney Docket Number	019282-000110US

ENCLOSURES (check all that apply)

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Date	September 16, 2002

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